

**REMARKS**

**I. Status Of Claims**

Claims 1-40 are pending.

Claims 1-40 stand rejected.

Claims 1, 8, 12, 13, 19, 26, 40 have been amended. No new matter has been added.

**II. Objection to the Specification**

**a. Summary**

The examiner has objected to the Summary of the Invention as containing informalities. More specifically, the examiner states "the summary ... is merely a reiteration of a claim and fails to summarize the novelty of the invention. Appropriate correction is required."

Applicant, through his attorney, wishes to thank the examiner for noting informalities in the Summary of the Invention and has included appropriate changes thereto. However, applicant transposes the examiner's objection to the Summary of the Invention as "merely a reiteration of a claim and fails to summarize the novelty of the invention." Applicant notes that "[s]ince the purpose of the brief summary ... is to apprise the public ... of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents.... The brief summary, if properly written to set out the exact nature, operation and purpose of the invention will be of material assistance.... The brief summary should be more than a mere statement of the objects of the invention." MPEP 608.01(d). Applicant submits that in this case, the Summary of the Invention satisfies the criteria recited in MPEP 608.01(d) as the nature, the specific operational steps and the purpose of the invention are disclosed. The nature of invention is a method and a system, the operational steps are those that constitute the invention and the purpose is to perform real-time like operations on batch files. Accordingly, applicant submits that the Summary of the Invention, as initially presented and amended herein, is in a form that is allowable under the present Patent and Trademark Office rules.

Having shown that the Summary of the Invention is in proper form, applicant respectfully requests that the amendments to the Summary be entered and the objection withdrawn.

**b. Abstract**

The examiner has objected to the Abstract as "it is not narrative in form."

Applicant, through his attorney, wishes to thank the examiner for noting informalities in the Summary of the Invention and has included appropriate changes thereto. However, applicant transposes the examiner's objection to the Abstract as "not in narrative form." Applicant notes that "a patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains ... Where applicable, the abstract should include the following ... (5) if a process, the steps." MPEP 608.01(b). Applicant submits that in this case, the Abstract presented satisfies the criteria recited in MPEP 608.01(b) as a less than 150 word concise statement of a method for a novel online-like processing of batch files using the enumerated processing step is recited. Accordingly, applicant submits that the Abstract, as initially presented and amended herein, is in a form that is allowable under the present Patent and Trademark Office rules.

Having shown that the Abstract is in proper form, applicant respectfully requests that the amendments to the Abstract be entered and the objection withdrawn.

**III. Rejection under 35 USC §112**

The examiner has rejected claims 12 and 13 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the examiner states "[c]laims 12 and 13 recite the limitation 'step of backup occurs' in claim 3. There is insufficient antecedent basis for this limitation in the claim. Correction is requested."

Applicant, through his attorney, wishes to thank the examiner for his observation regarding claims 12 and 13 and has amended these claims to provide proper antecedent basis. Claim 3, from which claims 12 and 13 depend, recites "**storing** the results ..." (emphasis added). In reply, applicant has amended the claims to recite the "step of storing" rather than "step of backup." Applicant submits that the amendments, i.e., "step of storing," made to claims 12 and 13 possess sufficient antecedent basis to render the claims not indefinite.

Having amended the claims to refer back to the "step of storing," applicant submits that the examiner's reason for rejecting the claims has been overcome and can no longer be sustained.

Applicant respectfully requests entry of the amendment, reconsideration and withdrawal of the rejection.

**IV. Rejection Under 35 USC §103**

The examiner has rejected claims 1-40 under 35 USC §103(a) as being unpatentable over Landry (USP No. 5,956,700) in view of Pare Jr. (USP No. 76154879). It is the examiner's position with regard to independent claims 1 and 19 that Landry "discloses the system and method for processing account information contained in batch files in an on-line manner, said method comprising reading at least one batch file ... (col. 11, lines 64 – col. 12, lines 19); identifying which of said plurality of records relates ... (col. 12, lines 40-65); processing each of said records ... (col. 13, lines 35-60). However, Landry didn't disclose: selecting and restricting access to one of said accounts ... On the other hand, Pare disclose: selecting and restricting access to said selected ones of said accounts (col. 9, lines 1-18), removing said restricted access ... (col. 14, lines 23-45). Thus, at the time the invention was made, it would have been obvious ... to include [the] step selecting and removing said restricted access in [the] Landry as taught by Pare. The motivation being to enable the users to improve security level to protect account information."

Applicant respectfully disagrees with, and explicitly traverses, the examiner's re-stated and new reasons for rejecting the claims. Applicant believes that the present invention is not obvious in view of the reference cited by the examiner. A claimed invention is prima facie obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

With regard to claim 1, this claim recites:

1. (Currently Amended) A method for processing account information contained in batch process files in an on-line like manner, said method comprising the steps of:  
    reading at least one batch file containing a plurality of records, each of said plurality of records ~~being related to an~~ associated with one of a plurality of accounts;  
    identifying which of said plurality of records relate to same ones of said plurality of accounts;  
    selecting and restricting access to one of said accounts;  
    processing each of said records identified as relating to said selected one of said accounts prior to processing any of said records relating to any other of said plurality of accounts; and  
    removing said restricted access to said selected one of said accounts after all of said records identified ~~with~~ as related to said selected one of said accounts are processed.

The references cited, individually or in combination, contrary to the examiner's position, do not teach, disclose, or provide the motivation for one skilled in the art to develop the novel features of the present invention as suggested by the examiner, as will be shown.

Landry discloses a system and method for paying bills without requiring interaction with the payors. "In its simplest form, bill generator 12 may use the Payee Information within the Payee Database 20 as a recurring datafile to search the Payor Information in the Payor Data-base 18 to generate bill records at predetermined times." (see col. 11, lines 64-68). "On some type of recurring basis, either periodically or at operator initiative, bill generator 12 processes generated bill records and transfers them to a TCF message generator 22." (see col. 12, lines 7-10). Hence, the Landry system teaches searching data files in a batch mode.

Pare discloses "a method for tokenless biometric access to financial accounts at an institution using an automated teller machine." (abstract). In this system, a user submitting a biometric is able to retrieve a list of accounts and the user is allowed to select a particular account on which to perform operations. (see col. 9, lines 1-5). Hence, Pare teaches a system that allows a user to access a selected one of the accounts available to the user. Pare does not

teach restricting access to the selected account. In fact, Pare teaches restricted access to all of the user's accounts except for the selected account.

Applicant appreciates the examiner's providing reference to specific statements in each of the cited references rendering the claimed subject matter obvious. However, applicant submits that in the matter of obviousness there is a great emphasis placed on "the importance of the motivation to combine." Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc., 231 F.3d. 1339, 56 USPQ2d. 1641, 1644 (Fed. Cir. 2000). More specifically, in the matter of obviousness, the court found that:

"an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *id.* quoting *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)"

In the instant case, the examiner believes that the Landry reference combined with the teachings of the Pare reference would be sufficient to render claim 1 obvious. However, the statements within the Landry and Pare references referred to by the examiner do not suggest any motivation to combine the references. The Landry and Pare references fail to ever disclose or suggest "selecting and restricting access" as recited in claim 1. In fact, Pare teaches away from "restricting access" as Pare allows for access of the one account but does not prohibit access to the other accounts identified with the user. Accordingly, one skilled in the art would not look to the Pare reference to find the motivation to modify the Landry reference to develop the novel features of the present invention. Rather, one skilled in the art may review the Landry reference

as a first step in learning batch process for bill payment. However, that person would not look to Pare to select and restrict access to one of the records as claimed because Pare does not suggest such a feature.

Furthermore, the examiner states that motivation to combine Landry and Pare would be to "enable the users to improve security level to protect account information." However, Landry does not suggest security is necessary, while Pare discloses a biometric security system that allows for a different mode of access than currently used; card number and password. In the present invention, security is not an issue. Rather, the restricted access is for the time that the records of an associated file are being processed. Accordingly, one would again not look to Landry and Pare to develop the novel features of the present invention.

Having shown that Landry and Pare do not teach, disclose or provide the motivation for one skilled in the art to develop the novel features of the present invention, applicant submits that the examiner's combination of such references is not justified. Accordingly, the reasons for rejecting the claims are not sustainable.

Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of claim 1.

With regard to independent claim 19, the examiner rejected this claim citing the same references used in rejecting claim 1. Thus applicant's remarks made in response to claim 1 are repeated with regard to claim 19. Accordingly, applicant submits that in view of the remarks made with regard to the rejection of claim 1, which are repeated herein in response to the rejection of claim 19, the examiner's rejection of claim 19 can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of claim 19.

The examiner has rejected each of the dependent claims based on a rejection of the independent claim from which they depend. More specifically, with regard to dependent claims

2 and 20, it is the examiner's position that "most of the limitations of these claims have been noted in the rejection of claims 1 and 19 above, respectively. In addition, Landry/Pare disclose: further comprising the step of: reporting the results of processing of each of said selected one of said accounts (col. 13, line 61 to col. 14, line 16, Landry)." With regard to dependent claims 3 and 21, the examiner recites the same rejection as recited against claims 1 and 19 and refers to col. 14, lines 17-39 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 4 and 24, the examiner recites the same rejection as recited against claims 1 and 19 and refers to col. 20, lines 19-39 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 5 and 25, the examiner recites the same rejection as recited against claims 1 and 19 and refers to col. 20, lines 41-54 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 6 and 24, the examiner recites the same rejection as recited against claims 1 and 19 and refers to col. 13, line 61 to col. 14, line 16 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 7 and 25 the examiner recites the same rejection as recited against claims 6 and 24 and refers to col. 34, lines 29-55 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 8 and 26, the examiner recites the same rejection as recited against claims 7 and 25 and refers to col. 34, lines 29-55 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 9 and 27, the examiner recites the same rejection as recited against claims 6 and 24 and refers to col. 34, lines 29-55 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 10 and 28, the examiner recites the same rejection as recited against claims 2 and 20 and refers to col. 13, line 61 to col. 14, line 16 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 11 and 29, the examiner recites the same rejection as recited against claims 2 and 20 and refers to col. 21, lines 1-25 of Landry as disclosing the subject matter of these claims. With regard to

dependent claim 12, the examiner recites the same rejection as recited against claim 3 and refers to col. 25, lines 25-50 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 3 and 21, the examiner recites the same rejection as recited against claims 13 and 39 and refers to col. 15, lines 3-7 of Pare as disclosing the subject matter of these claims. With regard to dependent claims 14 and 32, the examiner recites the same rejection as recited against claims 1 and 19 and refers to col. 24, lines 41-62 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 15 and 33, the examiner recites the same rejection as recited against claims 1 and 19 and refers to col. 27, lines 53-67 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 16 and 34, the examiner recites the same rejection as recited against claims 1 and 19 and refers to col. 26, lines 36-56 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 17 and 35, the examiner recites the same rejection as recited against claims 1 and 19 and refers to col. 24, lines 41-62 of Landry as disclosing the subject matter of these claims. With regard to dependent claims 18 and 36, the examiner recites the same rejection as recited against claims 1 and 19 and refers to col. 21, line 66 to col. 22, line 16 of Landry as disclosing the subject matter of these claims. With regard to dependent claim 30, the examiner recites the same rejection as recited against claim 21 and refers to col. 14, lines 17-39 of Landry as disclosing the subject matter of these claims. With regard to dependent claim 31, the examiner recites the same rejection as recited against claim 21 and refers to col. 14, lines 40-64 of Landry as disclosing the subject matter of these claims. With regard to dependent claim 40, the examiner recites the same rejection as recited against claim 19 and refers to col. 17, lines 39-55 of Landry as disclosing the subject matter of these claims. With regard to dependent claim 37, the examiner recites the same rejection as recited against claim 19 and refers to col. 13, lines 25-30 of Pare as disclosing the subject matter of these claims. With regard to dependent claim 38, the examiner recites the same



rejection as recited against claim 37 and refers to col. 25, lines 25-50 of Landry as disclosing the subject matter of these claims. With regard to claims 12-15, these claims ultimately depend from claim 11, which has been shown to be allowable. Accordingly, claims 12-15 are also allowable by virtue of their dependency upon an allowable base claim.

Accordingly, the applicant's remarks made in response to claims 1 and 19 are also applicable in response to the rejection of each of the dependent claims 2-18 and 20-40. Accordingly, applicant submits that in view of the remarks made with regard to the rejection of claims 1 and 19, which are repeated herein in response to the rejection of the dependent claims, the examiner's rejection of the claims can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of each of the dependent claims.

Applicant submits that the reasons for the examiner's rejection of the claims have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

**V. Claim Amendments**

Applicant has submitted amendments to claims 1, 8, 12, 13, 19, 26 and 40. With regard to claims 1 and 19, the amendments were made to more clearly state the invention. With regard to claims 8, 26 and 40, the amendments were made to correct the form of the claims. With regard to claims 12 and 13, the amendments were made to provide proper antecedent basis for the subject matter claimed therein. No new matter has been added by the amendments to the claims. Applicant further submits that the substance of the originally filed claims 1, 8, 12, 13, 19, 26 and 40 has not been amended and not been made to overcome any prior art cited by the examiner. Accordingly, the amendments made are not related to patentability and do not alter or limit the substance of the subject matter claimed.

**VI. Conclusion**

Having addressed the examiner's objections to the specification and rejection of the claims under 35 USC §§103, 112 second paragraph, applicant submits that the reasons for the examiner's rejection have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the objection and rejection and that a Notice of Allowance regarding claims 1-40 be issued.

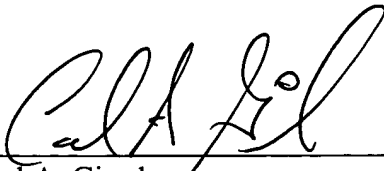
If the examiner believes that the prosecution of this matter may be advanced by a telephone call, the examiner is invited to contact applicant's attorney at the telephone number indicated below.

**VII. Fees**

No fees are believed necessary for filing this election and response. However, the Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to Duane Morris LLP deposit account 50-2061.

Respectfully submitted,

Dated: 7/21/03

  
\_\_\_\_\_  
Carl A. Giordano  
Reg. No. 41,780

DUANE MORRIS LLP  
100 College Road West, Suite 100  
Princeton, New Jersey 08540  
(609) 919-4402 (Telephone)  
(609) 919-4401 (Fax)  
CAG/\*

PTN\36388.2